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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,088	07/12/2001	Peter K. Malkin	YOR9-2001-0331 (8728-517)	1876

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,088

Applicant(s)

MALKIN ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-9, 16, 21-23 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Zweben et al. (US 2002/0169686).

Zweben et al. teach a method and system for using portable devices to provide merchandising information, comprising:

Claim 1.

receiving an electronic service request including a product identifier and a customer query from a customer within a sales environment [0041]; [0047];

retrieving data corresponding to the product identifier from a product database [0041];

determining a portion of the data relating to the customer query [0041];

delivering an electronic reply to the customer including the portion of the data corresponding to the product identifier and relating to the customer query [0041].

Claim 2. Said method and system, further comprising the step of issuing the customer a mobile device, wherein the mobile device issues the electronic service request [0039].

Claim 3. Said method and system, further comprising the step of issuing the customer a mobile device, wherein the mobile device determines the product identifier [0039].

Art Unit: 3629

Claim 4. Said method and system, further comprising the step of issuing the customer a mobile device and a corresponding customer identification (loyalty card) [0039].

Claim 7. Said method and system, further comprising the step of storing the service request in a customer database corresponding to the customer identification [0039]; [0042].

Claim 8. Said method and system, wherein the product identifier is determined according to one of a product radio frequency identification tag, a bar code scan, a verbal description provided by the customer, a digital photo, and an alphanumeric identification [0043].

Claim 9. See claim 1 and claim 2.

Claim 16. See claim 8.

Claims 21, 23 and 26. Receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *specified question or comment* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben et al. would be performed the same regardless if said customer query is a question or comment.

Claim 22. Receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *one of a digital photo and a voice memo* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben et al. would be performed the same regardless if said customer query is a question, a digital photo or voice memo.

Art Unit: 3629

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Lefkowitz (US 2002/0188501).

Claim 5. Zweben et al. teach said method and system, wherein the loyalty card (customer identification) is issued to the customer [0039].

However, Zweben et al. do not specifically teach that said identification is persistent.

Lefkowitz teaches a method and system for providing rebates based on purchases made at participating retailer locations, wherein a customer is provided with a customer identification badge containing customer identification information, and wherein said badge comprises a persistent memory module for storing said customer identification information [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said identification is persistent, as taught by Lefkowitz, because it would enhance the reliability of the system.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Official Notice.

Claim 6. Zweben et al. teach said method and system, wherein the loyalty card (customer identification) is issued to the customer and which is used at the time of service request [0039].

However, Zweben et al. do not specifically teach that said loyalty card (customer identification) is issued with the service request.

Official Notice is taken that it is well known that store loyalty cards or credit cards are offered to customers when the customers are shopping in the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said

Art Unit: 3629

loyalty card (customer identification) is issued with the service request, because it would allow merchants to collect information about customer shopping activity so to provide said customers with targeted advertisement in future based on said collected information, thereby increase revenue.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Saito et al. (US 2001/0014870).

Claim 10. Zweben et al. teach said method and system, wherein the customer identification and the mobile device are issued to the customer [0039].

However, Zweben et al. do not specifically teach that said customer identification associates the mobile device with the customer.

Saito et al. teach a method and system for electronic coupon management using radio LAN, including a portable terminal carried around by a customer present at the store, wherein when the portable terminal (terminal ID) is properly registered, a user registration confirmation message is issued [0115]; [0093].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said customer identification associates the mobile device with the customer, as taught by Saito et al., because it would allow to use just one mobile device for a household, thereby reducing costs associated with the mobile device.

Claim 11. Saito et al. teach said method and system, wherein the database stores the association between the mobile device and the customer [0115]; [0093]. The motivation to combine Zweben et al. and Saito et al. would be allowing to use just one mobile device for a household, thereby reducing costs associated with the mobile device.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. and Saito et al. and further in view of Official Notice.

Claim 12. Zweben et al. and Saito et al. teach making the association between the mobile device and the customer upon issuing the mobile device to the customer (See **claim 10** and **claim 11**).

However, Zweben et al. and Saito et al. do not specifically teach breaking the association of the mobile device with the consumer upon return of the mobile device to the business.

Art Unit: 3629

Official Notice is taken that it is well known in a communication service industry to retain business equipment when a customer brakes a contract for said communication services.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. and Saito et al. to include breaking the association of the mobile device with the consumer upon return of the mobile device to the business, because it would allow the business to use the same mobile device over and over again with new consumers, thereby saving funds.

Claims 13-15, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Godsey et al. (US 2002/0161651).

Claim 13. Zweben et al. teach all the limitatcns of **claim 13**, except: tracking the customer within the store based on a position of the mobile device in relation to a plurality of beacons.

Godsey et al. teach a method and system for tracking consumers in a store environment, wherein said tracking is based on a position of a mobile device (battery powered RF or IR transmitter tag) in relation to a plurality of sensors [0019]; [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include tracking the customer within the store, as taught by Godsey et al., because collected thereby information would allow merchants to better utilize a store floor space.

Claim 14. Godsey et al. teach said method and system, wherein a server stores positions over time as position data [0023]. The motivation to combine Zweben et al. and Godsey et al. would be to analyze the collected location information to better utilize a store floor space.

Claim 15. See **claim 13** and **claim 14**.

Claims 20 and 24. Zweben et al. teach all the limitations of claim 20, including determining a customer purchase order for a selected product [0042]; except tracking the mobile device issued to the customer to a checkout register; and delivering the selected product to the checkout register upon said tracking.

Godsey et al. teach said method and system, wherein tracking of said consumers and their shopping carts in a store environment is provided and conducted throughout the store. Tracking information is then tied in with purchasing data at the checkout registers, thereby obviously indicating delivering the selected product to the checkout registers [0019]; [0020].

Art Unit: 3629

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include tracking the customer within the store, as taught by Godsey et al., because collected thereby information would allow merchants to better utilize a store floor space.

Claims 17, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Ambrose et al. (US 2002/0065879).

Claim 17. Zweben et al. teach receiving user query via the mobile device; determining a response to the customer query; and delivering the response to the mobile device [0039]; [0041].

Zweben et al. do not specifically teach delivering an acknowledgment to the mobile device confirming the receipt of the customer query.

Ambrose et al. teach a method and system for transferring service requests and responses to the requests between a client and an enterprise server, including acknowledging receipt of the service request [0339].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include acknowledging receipt of the customer query, as taught by Ambrose et al., because it would allow to improve the customer service, thereby make it more attractive to the customers.

Claim 19. See claim 17 and claim 1.

Claim 25. Ambrose et al. teach: acknowledging receipt of the service request [0339]. The motivation to combine Zweben et al. and Ambrose et al. would be improving the customer service. Information as to *indication of the a number of preceding queries in the query quene* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben and Ambrose et al. in view of Yacoby et al. (US 6,516,311).

Claim 18. Zweben et al. and Ambrose et al. teach all the limitations of claim 18, except: parsing the customer query for at least one key word; and retrieving a response corresponding to the key word from a database.

Art Unit: 3629

Yacoby et al. teach a method and system for linking and directory assisting on the Internet, wherein a customer query is parsed for key words to retrieve matching information from a database (column 5, lines 56-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. and Ambrose et al. to include parsing the customer query for key words, as taught by Yacoby et al., because it would enhance the accuracy of matching the retrieved information to the consumer request.

Response to Arguments

Applicant's arguments filed 4/12/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that Zweben does not teach a customer query in addition to a product identifier, the examiner stipulates that Zweben specifically teaches: *user inputs specific product information, and consumer identification information* [0042].

In response to applicant's argument, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the applicant's argument that Zweben and Lefkowitz fail to teach a persistent customer identification, the examiner points out that Lefkowitz was applied to show providing a customer with a customer identification badge containing customer identification information, wherein said badge comprises a persistent memory module for storing said customer identification information (See Lefkowitz [0020] and discussion above).

In response to the applicant's argument that Zweben in view of Official Notice does not disclose issuing customer identification with a service request, the examiner maintains that Zweben discloses issuing a loyalty card to the customer, wherein said loyalty card identifies the customer [0039]. Furthermore, Zweben teaches requesting services by the customers [0042]. Official Notice indicated that it was old and well known to offer loyalty or credit cards to customers when the customers are shopping (requesting a service) in a store. The motivation to combine issuing customer identification with a service request

Art Unit: 3629

would be collecting by merchants information about customer shopping activity so to provide said customers with targeted advertisement in future based on said collected information, thereby increase revenue.

In response to the applicant's argument that the prior art does not teach that the customer query comprises one of a digital photo, a voice memo, a question or comment, examiner points out that Zweben teaches receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *the specific content of the query* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben would be performed the same regardless of the specific content of the query.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

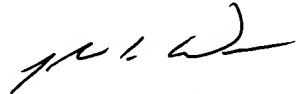
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Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.



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